

Remarks:

Applicants thank Examiner for his continued review and respectfully request further consideration of the present application and currently pending claims, in accordance with the following:

Claims

Claims 1, and 20 are amended herein, claims 8 – 19, and 22 have been canceled, and new claim 25 has been added, such that claims 1-7 and 20, 21, and 23 - 25 are currently pending and being prosecuted on the merits. New claim 25 depends from independent claim 20 and adds further limitations supported in the specification at ¶¶ [0020]-[0030]. As such, no new matter is introduced by new claim 25.

§ 103(a)

In the Office Action, Claims 1-7 and 20-24 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0059318 to Nomura et al., in view of U.S. Patent No. 6,965,449 to Sugiyama. For the subtle yet patentably distinct differences presented by the present invention and these references, Applicants maintain their traversal of this rejection.

It is initially noted that obviousness, presents a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, it is well settled that the PTO "bears the initial burden of presenting a prima facie case of unpatentability. . . ." In re Glaug, 283 F.3d 1335, 1338 (Fed. Cir. 2002). If the

Examiner fails to establish the requisite prima facie case, the rejection is improper. In re Rijckaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

The Examiner must satisfy three criteria in order to establish the requisite prima facie case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ 2d 1596 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442. Thus, "[m]easuring a claimed invention against the standard established by § 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

More recently, the U.S. Supreme Court has held that for a rejection under 35 U.S.C. § 103(a) to be proper, the Examiner must establish an "apparent reason" to modify the reference or to combine reference teachings. *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). The Court found that "[o]ften, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." *KSR*

Int'l Co. v. Teleflex, Inc., No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 14 (emphasis added).

Arguments based solely on "common sense" and mere conclusory statements of generalized advantages and convenient assumptions are inadequate to establish a motivation to combine. *In re Lee*, 61 USPQ2d 1430, 1434-1435 (Fed. Cir. 2002), and *In re Beasley*, Civ. App. 04-1225, slip op. at 6-7 2004 WL 2793170 (Fed Cir. Dec. 7. 2004) (unpublished). In *Lee*, for example, the court held that the examiner's unsupported assertion that "another motivation would be that the [claimed feature] is user friendly and it functions as a tutorial" was based only on subjective belief and unknown authority and therefore did not adequately address motivation to combine. *In re Lee*, 1434.

Similarly, in *Beasley*, the court rejected as inadequate the examiner's unsupported assertions that certain resulting advantages would motivate one with ordinary skill in the art to combine prior art references to arrive at the claimed invention, and stated:

Given the subtle but powerful attraction of a hindsight-based obviousness analysis, we require a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references....The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another without providing a citation of any relevant, identifiable source of information justifying such substitution. The statements made by the examiner upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans.

In re Beasley, slip op. at 10.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification.*" *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984).

Finally, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification" MPEP §2143.01 (citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)); and "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.02(VI) (citing *In re Ratti*, 123 USPQ 349 (CCPA 1959) (holding that obviousness is not supported where the 'suggested combination of references would require substantial reconstruction and redesign of the elements shown in the [primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.')).

The primary reference is again Nomura, which discloses a system for restricting image formation in networks that heavily relies upon the "image data" (i.e. the file to be printed).

Nomura discloses that "[a]n object of the present invention is to provide an image processing system for realizing efficient use of the system by restricting the use of an image forming device and devices (digital complex device, scanner device, etc.) of the image processing system by judging whether these devices are used for intended purposes (whether used privately or not)." Nomura, ¶ [0017]. Exemplary image data categories such as color composition are then considered to teach a method of use and function of the system therein.

Further, Nomura provides ". . . the image data to be used in business is anticipated and its attributes are set in advance, so as to carry out the control of restricting the output of those image data which do not match the attributes by the attributes judging section. As a result, it is possible to judge those image data which are to be used for private purposes." ¶ [0026]

With particular respect to the present invention, Nomura discloses objectively restricting outputs based upon time zone or working environment, "without adding

special restriction data to the image data." ¶ [0030] In this configuration, "... the control section 7 includes a judging section which judges the operating environment of the image forming device, and a control section which controls whether to execute image output based on the operating environment. ¶ [0078].

Nomura however fails to teach and/or suggest each and every limitation of the present invention. First, the image forming device therein "is to be used in a network environment..." ¶ [0082] Though it discloses restricting outputs based on data format, software information, time information, recording medium, and post-process functions, and even restricting "the number of pages which can be used to continuously record the image in the image forming section (the number of multiple pages, or the number of pages in a single print job)" ¶ [0106], it fails to disclose a method of restricting the *execution* of the user request. The main difference here is that a stand alone addition to a printer is present by the present invention, whereas Nomura discusses a complex control algorithm to be performed by a network (server). For example, the claims each describe "receiving data...", which incorporates the destination functionality of a printer (for example), rather than a network server. Further, the claims affirmatively recite "printing" the data, which a network controller or server cannot do. In the present invention, it is the print request that is considered, as opposed to the image data itself.

Because Nomura does not present a printer-based process it fails to teach restriction based on double or single-sided printing, landscape versus portrait, single or double pass printing, as well as many other printing styles, medium surfaces, positioning (near the edges, etc.), resolution, speed, etc., as offered by the present invention.

Again, as stated therein Nomura's system is to be used with a network. The present invention is employable by a stand-alone printer and printer driver, wherein it is appreciated that many small offices and businesses, exposed to after-hour work crews and/or traffic, do not have networks.

Amendment

To that end, the claims have been amended to further distinguish the present invention from the prior art references of record.

In the event of any questions, the Examiner is urged to contact the undersigned.

Respectfully Submitted,

SLJ, LLC
Intellectual Property Attorneys

By: 
William J. Jacob #51173
324 E. 11th Street, Suite 101
Kansas City MO 64106
Telephone: (816) 204-6430
Fax: (816) 221-2575

(Docket No. 200209506-1)